

No. 3618

IN THE  
**United States Circuit Court of Appeals**  
For the Ninth Circuit

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MAJESTIC ELECTRIC DEVELOPMENT COMPANY,  
*Appellant,*

VS.

WESTINGHOUSE ELECTRIC & MANUFACTURING  
COMPANY,  
*Appellee.*

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**APPELLANT'S OPENING BRIEF.**

[DESIGN PATENT No. 51253, ELECTRIC HEATER CASING.]

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## APPELLANT'S OPENING BRIEF.

[DESIGN PATENT No. 51253, ELECTRIC HEATER CASING.]

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This case involves design patent No. 51,253, granted on September 11, 1917, to Edmund N. Brown, assignor to the Majestic Electric Development Company, the appellant, for an electric heater casing. It is a companion case to case No. 3616, already argued in this court. The two cases were tried consecutively in the lower court.

Case No. 3616 involved design patent No. 51,043, issued to the same inventor. The applications for the patents were pending in the Patent Office at the same time. The first mentioned design was applied for on May 28, 1917, and issued July 17, 1917. The present

design was applied for on July 10, 1917, and issued on September 11, 1917.

The mechanical difference between the two designs resides principally in the fact that in design patent 51,043, there is an annular flange around the edge of the reflector, whereas in design 51,253 that flange is omitted, and its place supplied by a beading of metal.

In both cases the alleged infringing device is the same, it being contended by appellant that said alleged infringing device is an infringement of both designs.

In case 3616 the lower court held that the appellee's device was not an infringement, but did not hold that the patent was invalid. In the case at bar the lower court held that the patent No. 51,253 was invalid, and, therefore, it was unnecessary to discuss the question of infringement. If patent 51,253 be valid, then it follows conclusively that infringement exists. A casual glance at the two devices is sufficient to prove this contention. Therefore, on this appeal we are concerned only with the question of validity of the patent 51,253, and that is the only question before this court.

This case was tried immediately after the trial of the cases 3616 and 3617 (the first involving design patent 51,043 and the latter involving the Brown mechanical patent, No. 1,245,084). The opinion of the lower court is an omnibus one in respect of all three patents, and appears between pages 19 and 33 of the record. That portion of the opinion relating to the two design patents begins in the middle of page 27, and the portion of the opinion relating specifically to the

patent now under consideration begins in the middle of page 29.

The opinion of the lower court holds that the patent in suit is invalid (1) by reason of want of invention, and (2) by reason of anticipation.

#### **As to Want of Invention.**

In the first place it seems to be the view of the lower court that this patent 51,253 is void for want of invention because of the existence of Brown's other design patent, 51,043. While there is no express statement to that effect in the opinion, nevertheless it was urgently insisted on by counsel for appellee at the trial, and we have no doubt that it played an important part in influencing the court's opinion. The theory of appellee in this respect is that Brown's patent 51,043, is a prior patent to the one in suit, and must be considered as a part of the prior art, and that the mechanical differences between the two patents are that the first one has an annular flange, whereas the second one omits that flange. Therefore, the contention is that it required no invention to omit the flange, and perforce the patent is void. This is an erroneous view to take of the controversy.

The two inventions were contemporaneous and were pending in the Patent Office at the same time. Consequently, patent 51,043, though issued shortly before patent 51,253, is no part of the prior art as to 51,253. It is settled law that as between co-pending applications by the same inventor covering analogous struc-

tures, neither of the patents when issued can be used in anticipation of the other or as limiting the other.

*Century Co. v. Westinghouse*, 191 Fed. 352;

*Anderson v. Collins*, 122 Fed. 458;

*Graham v. Geneva Lake Co.*, 11 Fed. 141;

*Graham v. McCormick et al.*, 11 Fed. 863;

*Westinghouse v. Dayton*, 106 Fed. 724 (affirmed in 118 Fed. 562);

*Ide v. Trorlicht*, 115 Fed. 145.

Such is the case now in hand. Brown made two inventions simultaneously and filed two applications for said inventions. Both applications were on file in the Patent Office at the same time. The Patent Office had both of them under consideration at the same time, and in due and regular course issued patents for each of them. The fact that one was issued a few days before the other does not make it a prior patent or a part of the prior art as to the other. Therefore, if the ruling of the lower court was based on appellee's argument that patent 51,043 is an anticipation of 51,253, such ruling was an error.

But the main ground relied on in the opinion of the lower court as showing want of invention is that the patent is void because the device has no surface ornamentation. When considering these designs, the lower court used this language, beginning at the bottom of page 28 of the record:

“But in the second place, in so far as they are alike, the plaintiff's casings, as well as those of the defendants, are entirely devoid of purely ornamental features, either of form or drapery; they are nude utilities. That,

of course, is not to say that they are without comeliness. By reason of their simplicity and symmetry and the 'glow', they may be pleasing to the eye; but the point is that they are bare mechanisms, no part or lines of which can be dispensed with or substantially altered without impairing their utility, and one cannot, under cover of a design patent, debar others from employing the mechanical means necessary to give effect to a known and useful mechanical principle, however pleasing to the eye such requisite mechanism may be."

We have already argued this point at page 32 et seq., of our brief in the companion case 3616, and we refer your honors to that portion of our brief in that behalf. It would serve no purpose of utility to dwell further on the matter in the instant case. We merely repeat in substance what we said there, that the remarks of the court quoted evince a misconception of the fundamental law of design patents. While surface ornamentation may be the subject matter of a design patent, it is equally true that contour, form, configuration and symmetry of parts may also be the subject matter of a design patent. It is the *appearance* of the article which the law says is patentable, and it is frequently the case that "nude utilities" have been covered by valid design patents. Indeed the opinion of the lower court virtually concedes this when it says that this design is not "without comeliness"; and the further statement of the court that "by reason of their simplicity, and symmetry, and the 'glow' they may be pleasing to the eye". If those statements be true, then this is a valid patent.

But furthermore, the lower court ignored the appearance of the article "as a whole", that is to say,



the impression produced upon the mind by the article "as a whole". In this connection we refer your honors to our brief in the case No. 3616 beginning at the middle of page 33 thereof.

There is one matter, however, which we omitted to dwell on in that brief and which we now call to the court's attention. It is this: *The distinctive form of arched guard wires forming the protective cage in front of the reflector is an essentially distinctive feature, which more than anything else, or as much as anything else, gives to the article a distinctive appearance.* It is something which catches the eye of the observer immediately, and its form is not a "nude utility". On the contrary its form is ornamental and is designed for that purpose. It would have been easy enough for the defendant to have adopted a flat wire screen, such as shown in Defendant's Exhibit 8 and Defendant's Exhibit 15, or even that shown in Defendant's Exhibit F (Morse Patent), and in such case the article would present a changed appearance. But instead of taking the flat form of wire screen the defendant uses the particular form of *arched wires* for making its protective cage, and thereby closely simulated the appearance of the patented design.

And as to the form of pedestal defendant could have used the four-legged stand of the Ferranti Fires; but instead thereof it simulated the circular base plate and upright standard of plaintiff, even simulating the color.

It follows, therefore, that the learned judge of the lower court was in error when he asserted that "no



parts or lines'' of the plaintiff's heaters could "be dispensed with or substantially altered, without impairing their utility".

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#### AS TO ANTICIPATION.

The decision of the lower court relies upon the following as showing anticipation of the patent in suit, viz.:

(1) Taylor English Patent, No. 102,070 of November 16, 1916;

(2) U. S. Warner Patent, No. 1,120,003, of December 8, 1914;

(3) English Patent to Simplex Conduits, 19,971, of September 4, 1914;

(4) The Ferranti Fire.

#### As to the Taylor English Patent.

It is apparent from a reading of the opinion of the lower court that primary reliance was placed thereon, more than upon anything else, for anticipation. At page 27 of the record, in discussing the Brown mechanical patent, it is said:

"Material also are the Warner Patent \* \* \* and the Taylor Patent of Nov. 16, 1916 (English 102070)."

And at page 30 of the record, when discussing specifically the design patent in suit, No. 51,253, it is said:

"Moreover the design is almost identical with that shown in Fig. 1 of the Taylor patent above referred to (English 102070). Substantial identity is expressly conceded by counsel for the plaintiff, who, however, contests the priority of the Taylor patent. It is true that

while this patent was applied for on January 11, 1916, it was not finally issued until November 15, 1916. It is further true that Brown's 'invention' as disclosed in his mechanical patent and his design patent 51,043 (covering the annular flange) was made as early as April, 1916, although the patents were not applied for until the following year. But if there is any evidence that the design invention of patent 51,253 antedates the application, which was filed July 10, 1917, it has escaped my attention. It is not without significance that in the application for the Taylor patent, made before any of the Brown 'inventions', the applicant carefully limited her claim with the explanation that she was 'aware that it is not broadly new to construct an electric radiator with a resistance wire wound spirally upon a tubular member made of refractory material, such resistance element being mounted in front of a reflector, with a protecting guard in front of the element.'"

It is quite apparent from the above that the decision is primarily based on the contention that the Taylor English patent is a clear anticipation of the patent in suit. But in regard to that matter we call the court's attention to this fact,

*That this Taylor patent was not put in evidence in the case at bar, nor is it in the record.*

It is not noted nor referred to in the statement of evidence (Record 36-108). It is not in the record here anywhere. It is not before this court. It is not physically present, and this court has no means of knowing its existence or its contents.

Therefore, the lower court committed an error in considering this English patent of Taylor. Every case must be decided upon the record before the court, and the court has no warrant or authority for considering

and being influenced by matters outside of the record, even though the judge may have some private information of its own regarding such matters outside of the record. Of course it goes without saying that the lower court cannot take judicial knowledge of the existence or contents of an English patent which was not put in evidence. In respect of this English patent, therefore, the lower court committed a plain and palpable error in basing its decision thereon, and for that reason alone the decree must be reversed.

As an explanation of this glaring error, though this is entirely off the record, we state that after the trial of the case at bar the case of this plaintiff against another company, to wit, Holbrook, Merrill & Stetson, was had, which last named case was defended by other attorneys than those appearing for the Westinghouse Company in the instant case. Those attorneys were Heard, Smith & Tennant of Boston and Samuel Knight, Esq., of San Francisco. *That case against Holbrook, Merrill & Stetson did not involve the patent in suit here*, but involved the first design patent of Brown, 51,043, and the Brown mechanical patent 1,245,084. In that case this English patent of Taylor was put in evidence and duly considered; but it was not put in evidence in the instant case, nor was it stipulated that it should be considered as being in evidence by reference, nor that it should be considered in the instant case. It seems that the learned judge of the lower court *ex moro motu* and without consent of counsel considered the Taylor English patent to be in evidence in the instant case. This was a plain and palpable error.

Furthermore, at page 30 the opinion of the lower court says that substantial identity between the design of the patent in suit and the Taylor patent was expressly conceded by us, and that we relied upon the fact that Brown's invention antedated the issuance of the Taylor patent, but that there was no evidence to show that Brown's invention actually did antedate it.

In answer to this we desire to say that we did not make any such concession in *this* case, which is now before the court, and that for the simple reason that the Taylor patent was not in evidence in this case and, therefore, there was no occasion to make any such concession, nor even to consider the Taylor patent at all. We did make such concession in the case against Holbrook, Merrill & Stetson, which case was based on Brown's other design patent, 51,043, and then nullified the effect of such concession by proving the date of Brown's invention of his first design patent, 51,043, to be prior to the date of issuance of the Taylor patent. We showed that the date of the Brown invention, 51,043, was as early as April, 1916, whereas the date of issuance of the Taylor patent was November 15, 1916. That was a complete answer to the Taylor patent as an alleged anticipation of the Brown patent, 51,043, in the suit against Holbrook, Merrill & Stetson. But in the instant case, there was no occasion for us to carry the date of Brown's invention of patent 51,253 back of the date of issuance of the Taylor patent for the reason that the Taylor patent was not in evidence in this case. If the Taylor patent has been put in evidence in this case, then we would have answered it in pre-

cisely the same way that we answered it in the Holbrook, Merrill & Stetson case; that is to say, we would have proved the date of invention of Brown's patent 51,253 to be prior to the date of issuance of the Taylor English patent. But as the Taylor patent was not in evidence in the instant case, there was no occasion for us to prove our invention as of a date anterior to the Taylor patent. By reason of these facts we did not carry the date of Brown's invention of patent 51,253 back of its application date. There was no occasion to do it. We submit that the decision of the lower court is contrary to law in that it is based upon matter which was not in evidence in the case. Is it possible that such a decree can be sustained?

**As to the Other Anticipating Patents Referred to in the  
Opinion of the Lower Court.**

We have already considered these in our two briefs in cases 3616 and 3617, and it would subserve no purpose of utility to dwell upon them in the instant case. The Warner, the Simplex and the Ferranti Fire show devices of distinctly different appearance to the eye from that of the patent in suit. A most casual glance at them will prove this contention.

The WARNER device by reason of its large circular metal grid work and electric light bulb in the center of the bowl, and by reason of the absence therefrom of arched guard wires in front, is clearly distinctive in appearance from the device of the patent in suit. No one would ever take our device for Warner's, nor Warner's device for ours. They are wholly different and

distinctive in appearance to the eye, and that is the test of a design patent.

The English patent of **SIMPLEX CONDUITS** shows a cone with corrugations or flutes on its interior, and its appearance to the eye is also sharply and distinctively different from that of ours. One particular difference which may be noted is the absence of a protective cage of arched wires in front. In the illustration shown in Defendant's Exhibit 8 the protective cage is shown as a flat wire mesh screen, which is wholly different in appearance from ours. In the drawings of the Simplex patent itself no protective guard of any kind is illustrated. In the specification it is said, that in order to protect the heating element, "the open end of the reflector should be fitted with a detachable rim carrying a grating of coarse wire mesh or the like". This seems to be in accordance with the design shown in Defendant's Exhibit 8.

In this Exhibit 8 it is also to be noted that the reflector is mounted on a highly ornate and decorated stand or support, having four legs to rest on the floor, thereby accentuating the difference in appearance between the Simplex heater and ours.

As to the **FERRANTI FIRE**, shown by a cut in Defendant's Exhibit 4, the following facts are to be noted:

- (1) It has a wide circular quartz plate, which gives the device a peculiar and distinctive appearance.

- (2) It has no protective cage of arched guard wires in front, nor any protective cage of any kind whatever.



(3) It is mounted on a peculiarly shaped stand having four legs resting on the floor.

(4) It presents a low and squatty appearance.

These differences are all distinctive as to appearance, and we do not think it possible for any one, so far as the appearance is concerned, to take a Ferranti Fire for a Brown heater, or a Brown heater for a Ferranti Fire.

Applying the rule of law applicable to design patents, we submit that the appearances of the two devices to the eye are wholly distinctive and different.

**Was there a Mis-trial?**

This is the same question already discussed by us in cases 3616 and 3617, and we refer your Honors to our briefs in those two cases on that point.

All of which is respectfully submitted.

Dated, San Francisco,     "

February 21, 1921.

JOHN H. MILLER,

*Attorney for Appellant.*



